

Application Number: 09/884,249

Docket Number: 10017175-1

REMARKS

Upon entry of this Response, claims 1-20 remain pending in the present Patent Application. Applicants request reconsideration of the pending claims in view of the following remarks.

Next, in items 5-9 of the Office Action, claims 1-20 have been rejected under 35 U.S.C. §103(a) as being obvious over the US Patent Application entitled "System and Method for Distributed Processing filed on March 6, 2001 (Application Number 09/799,381) by Jia and subsequently published as US Patent Application Publication US/2002/0129097A1 in combination with US Patent References 6,718,329 (Selvin); 6,360,252 (Rudy et al); 6,101,510 (Stone et al.); 20030041110 (Wenocur et al.); 5,974,346 (Poledna); and/or 6,380,935 (Heeschen et al.). Applicants once again assert that the rejection of claims 1-20 is improper as US Patent Application Publication US/2002/0129097A1 by Jia is disqualified as a reference as provided by 35 U.S.C. §103(c).

Specifically, 35 U.S.C. §103(c) provides:

"Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." [Emphasis added]

US Patent Application Publication US/2002/0129097A1 qualifies as prior art only under §102(e)(1). Given that the invention that is the subject of the present application and the subject matter of US Patent Application Publication US/2002/0129097A1 by Jia were either owned by or subject to assignment to the same entity at the time the present invention was made, then US Patent Application Publication US/2002/0129097A1 is disqualified as prior art under §103(c). In the prior Response of 12/8/04, a statement was provided and is reproduced below in the following section that at the time the invention of the present application was made, both the subject matter of US Patent Application Publication US/2002/0129097A1 and the present invention that is the subject of the present Patent Application were owned by, or subject to an obligation of assignment to the same person or entity.

Nonetheless, with regard to disqualification of US Patent Application Publication US/2002/0129097A1 as prior art under §103(c), in the "Response to Arguments", the Final Office Action states as follows:

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"Applicant's arguments filed December 10, 2004 have been fully considered but they are not persuasive. Regarding claims 1-20, Applicants assert that the rejection of claims 1-20 is improper as US Patent Application Publication US/2002/0129097A1 by Jia is disqualified as a reference as provided by 35 U.S.C. §103(c), (p. 4, lines 19-22). The Examiner disagrees because 35 U.S.C. §103(c) states that Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, *at the time the invention was made*, owned by the same person or subject to an obligation of assignment to the same person. At the time this invention was made, June 18, 2001, the claimed invention was not subject to an obligation of assignment. Assignment to the Hewlett-Packard Company was recorded on September 6, 2001, after the time the invention was made."

Applicants respectfully disagree with the above statement. Specifically, the plan language of §103(c) states that at the time the invention was made (June 18, 2001 for the present invention), the invention was either owned by or subject to an obligation of assignment the same person (HP).

The Examiner correctly notes that the present patent application was filed on June 18, 2001 and the Assignment that assigned the rights under the present patent application to Hewlett-Packard was recorded nearly 3 months later on September 6, 2001. **However, each of the inventors of the invention expressed in the present patent application were under a contractual obligation to assign their invention to Hewlett-Packard Company at the time the invention was made.** The fact that the Assignment was recorded nearly 3 months after the filing of the Patent Application merely reflects the fact that it is often desirable not to file Assignments with the Patent Application so as to be able to add the application number and official filing date to the Assignment once the postcard or filing receipt have been received from the US Patent and Trademark Office. Also, the filing of the Assignment may have been delayed due to the normal pace of administrative functions.

In addition, Applicant wishes to direct the Examiner's attention to the MPEP §706.02(I)(2) which states:

"The question of whether common ownership exists at the time the claimed invention was made is to be determined on the facts of the particular case in question. Actual ownership of the subject matter and the claimed invention by the same individual(s) or organization(s) or a

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legal obligation to assign both the subject matter and the claimed invention to the same individual(s) or organization(s) must be in existence at the time the claimed invention was made in order for the subject matter to be disqualified as prior art." (Emphasis Added)

As stated above, the inventors of the present invention that is the subject of the present patent application were each under a legal obligation to assign their rights to the invention over to the Assignee Hewlett-Packard Company at the time the invention was made.

Since the inventors of the invention of the present patent application were subject to an obligation to assign the invention to HP at the time of the invention, Applicant once again asserts that US Patent Application Publication US/2002/0129097A1 is properly disqualified for use as a prior art reference under §103. Accordingly, once again, Applicants assert that the rejection of claims 1-20 as being unpatentable over US Patent Application Publication US/2002/0129097A1 in combination with other references is improper. Therefore, Applicants request that the rejection of claims 1-20 be withdrawn.

STATEMENT OF COMMON OWNERSHIP UNDER 35 U.S.C. §103(c)

Applicants hereby state that both the subject matter of US Patent Application Publication US/2002/0129097A1 and the present invention that is the subject of the present Patent Application were, at the time the present invention was made, owned by the same person or entity, or subject to an obligation of assignment to the same person or entity.

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CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,



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